

Remarks

I. Status of Claims

Claims 1-204 are pending in this application. Claims 1-100, 106-114, 116-120, 122, 128, 132-141, 153-160, 162-165, 167, 173, and 178-186 have been withdrawn by the Examiner.

Figure 1 has been submitted herewith. Support for Figure 1 can be found, for example, at page 9, lines 15-19 of the specification as filed (describing the nature of the thermogram and of both peaks observed therein), at page 12, line 16 through page 14, line 2 (describing DSC, the utility of DSC, the experimental procedure, and the scientific theory behind DSC), at page 14, line 3 through page 15, line 16 (explaining the thermogram in Figure 1). Thus, the specification specifically describes the results depicted in the figure and how one of ordinary skill in the art can obtain the results presented in the figure, *i.e.*, how to make the product tested and how to test the product. Thus, the figure is already inherently described and is not new matter.

Claims 101 and 196 have been amended to more clearly describe the claimed invention. Specifically, these claims have been amended to recite a heat-activated composition. Support for this amendment can be found throughout the application as originally filed, such as, for example, at page 7, lines 1-2, and Example 2 at page 29.

Claims 201-204 have been added. Support for these claims can be found throughout the application as originally filed, such as, for example, at original claim 2,

now cancelled, and at page 8, lines 12-16; at page 8, line 1 and Example 2; at page 8, lines 3-4; and at page 8, lines 5-11.

Accordingly, since it was clear from the specification that the compositions of the invention required heat activation, these amendments only explicitly state what was implicitly understood to be the scope of the claims in view of the specification. Thus, these amendments in no way narrow the scope of the amended claims, nor do they add new matter.

II. Specification

Applicants have now removed the paragraph cited by the Examiner at page 9, thus rendering the objection moot.

III. Rejections under 35 U.S.C. § 112, second paragraph

Claims 115 and 161 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly claim the subject matter which Applicants regard as the invention. See pages 3-4 of the present Office Action. Applicants respectfully traverse.

In order to meet the requirements of 35 U.S.C. § 112, second paragraph, the claims must define the patentable subject matter with a reasonable degree of particularity and precision. M.P.E.P. § 2173.02 (emphasis in original). The Federal Circuit has decided that the definiteness of the claim language must be analyzed, not in

a vacuum, but in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.*

The definiteness of a claim is an objective inquiry which evaluates whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. See e.g., M.P.E.P. § 2171. Applicants submit that the metes and bounds of claims 115 and 161 are defined with the requisite reasonable degree of particularity and precision such that it would have been clear to one of ordinary skill in the art. The American Heritage College Dictionary (Third Edition) defines the verb "derive" as "4. *Chem.* To produce or obtain (a compound) from another substance by chemical reaction." Further, The American Heritage College Dictionary (Third Edition), defines "derivative" as "[a] compound derived or obtained from another and containing the essential elements of the parent substance." Thus, one of ordinary skill in the art would recognize that, according to claims 115 and 161, the C3 to C5 monosaccharides may be chosen from furanoses and compounds produced from furanoses which contain the essential elements of the parent furanose. Thus, in contrast to the Examiner's assertion, as understood by one of ordinary skill in the art, dihydroxyacetone would not be considered a furanose derivative, at least because it does not comprise the essential elements of the parent furanose.

Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

IV. Rejection under 35 U.S.C. § 102

Claims 101-105, 115, 121, 123-127, 129-131, 142-146, and 196-197 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,688,930 ("*Bertho*") for the reasons set forth on pages 4-5 of the present Office Action.

Applicants respectfully traverse, however, in order to expedite the prosecution of the present application, claims 101 and 196 have been amended to recite that the inventive composition is heat-activated. As defined in the present specification, at page 8, a heat-activated composition protects and/or repairs at least one keratinous fiber better than the same composition which is not heated during or after application to the at least one keratinous fiber.

A rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. See *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); see also M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."). In the present case, *Bertho* does not teach, either explicitly or impliedly, a heat-activated composition for protecting or repairing at least one keratinous fiber according to the present invention.

Accordingly, for at least this reason, Applicants respectfully request withdrawal of this rejection.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

V. Rejection under 35 U.S.C. § 103

Claims 101-105, 115, 121, 123-127, 129-131, 142-152, 161-166, 168-172, 174-177, and 187-199 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,004,545 ("*Karlen*") in view of U.S. Patent 5,688,930 ("*Bertho '930*") or U.S. Patent No. 6,087,403 ("*Bertho '403*") for the reasons set forth on pages 5-7 of the present Office Action. Applicants respectfully traverse.

The Examiner asserts that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of *Karlen* by the use of polyglycoside mixtures instead of alkylpolyglucosides." See pages 6-7 of the present Office Action. However, as discussed above, claims 101 and 196 have been amended to recite that the inventive composition is heat-activated. Thus, even if the proposed modification was made, the resultant composition would not render the presently claimed composition obvious as *Karlen* does not teach or suggest a heat-activated composition.

Accordingly, for at least this reason, Applicants respectfully request withdrawal of this rejection.

VI. Conclusion

Applicants respectfully request the reconsideration and the timely allowance of the pending claims.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Attorney Dock t No. 05725.0783
Applicati n No.: 09/820,812

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Thalia V. Waunemest, Reg No. 39,064

By: *for Anthony Tridico*
Anthony Tridico
Reg. No. 45,958

Date: August 21, 2002

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Appendix

Version with markings to show changes made pursuant to 37 C.F.R. § 1.121(c)(1)(ii):

101. (Amended) A composition for protecting at least one keratinous fiber from extrinsic damage or repairing at least one keratinous fiber following extrinsic damage comprising at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁ to C₂₂ carbon chain, wherein said at least one compound is present in an amount effective to protect said at least one keratinous fiber from said extrinsic damage or to repair said at least one damaged keratinous fiber, and further wherein said composition is heat-activated.

196. (Amended) A kit for protecting at least one keratinous fiber from extrinsic damage or for repairing at least one keratinous fiber following extrinsic damage comprising at least one compartment,

wherein said at least one compartment comprises a composition comprising at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁ to C₂₂ carbon chain, wherein said at least one compound is present in an amount effective to protect said at least one keratinous fiber from said extrinsic damage or to repair said at least one damaged keratinous fiber, and further wherein said composition is heat-activated.